

REMARKS

In the Official Action the examiner rejected Claim 3 under 35 U.S.C. § 112.

Applicant has canceled Claim 3.

The Examiner rejected all of the claims, Claims 1-12, under 35 U.S.C. § 103(a) as being unpatentable over the Ong reference, U.S. Patent No. 5,727,816 (Ong '816) in view of the Podosek reference, U.S. Patent No. 5,947,524 (Podosek). Applicant has amended all of the independent claims, Claims 1, 6, and 9 to more specifically define Applicant's claimed invention and to distinguish it from the references relied upon for rejection.

The Ong '816 reference discloses a document binder system in which a report cover 14, like the binder of the present invention, is also formed of a single sheet of material and folded in precisely the same way as the document binder of the present invention.

However, the Ong '816 reference does not include any seal between the return panel 34 and the facing surface of the top cover panel 30. Indeed, such a seal would serve no useful function since the return panel 34 and the top cover panel 30 are both securely fastened to each other and to the stack 12 of a plurality of sheets of paper by several wire staples 16.

For the same reason a person of ordinary skill in the art would have no motivation to provide the Ong '816 reference with the barbed, channel shaped clasp of the Podosek reference, described as a "binder 13" and depicted in Fig. 4(a) of the Podosek reference. Such a "clasp", as required in the present application, or "binder" as termed in the

Podosek reference would serve no useful function whatsoever if incorporated into the Ong '816 reference, since such a clasp would be totally redundant in view of the use of the staples or pronged fasteners envisioned in the Ong '816 reference (Ong '816, col. 11, lines 42-44).

By the same token it would not be obvious to a person of ordinary skill in the art to substitute the folded, single sheet report cover 14 of the Ong '816 reference for the two-piece cover 15 of the Podosek reference. In the Podosek reference the cover 15 is comprised of a single sheet 32 of plastic folded to form a pair of sheets 33 and 35 and an elongated strip 36 that includes a lock portion 45 and a securing portion 47 (Podosek, col. 7, lines 54-58 and col. 8, lines 4-8). The fundamental principle of operation of the Podosek reference relies upon the fact that the lock portion 45 is not secured to the side 43 of the sheet 33, but rather forms an acute angle δ at its intersection with exterior side 43 of sheet 33. This is because the lock portion 45 extends up between the side wall 23 of the binder 13 and the slanted rib 31. Podosek relies upon the interlocking engagement of the lock portion 45 to effectively lock the cover 15 in the slot 25 (Podosek, col. 8, lines 11-32).

To eliminate the freely projecting lock portion 45, which can only be achieved with the two-piece construction shown in the Podosek reference, and to substitute in place of that the single sheet document cover employed in the Ong '816 reference, would be totally

contrary to the fundamental principle of restraint forming the entire basis of capturing the papers P taught in the Podosek reference. This is particularly true if the binding return panel is sealed throughout to the top binding panel, as now required in all claims of the present application. As the held in Ex Parte Jackson, 146 USPQ 409 (1964):

"Claims are not rejected as unobvious over primary reference in view of secondary reference where to so modify device of primary reference would destroy its structural identity and mode of operation".

Likewise, As held by the Patent Office Board of Appeals in Ex parte Harris, 94 USPQ 282 (BPA&I 1952):

"Modification of references would be contrary to purposes of prior structures and also could be made only in light of applicant's teachings; therefore, modification is not proper basis for rejection of claims."

The principle of operation taught throughout the Podosek reference is the use of an elongated strip having a securing portion and a lock portion in which the lock portion forms an acute angle at its intersection with the cover sheet and extends up into the area between the rib and side wall of the binder to retain the cover within the binder (Podosek, col. 3, lines 25-36; lines 55-66; col. 4, lines 19-29; lines 43-57; col. 5, lines 8-20; lines 38-50; col. 6, lines 1-12; col. 8, lines 4-25; lines 45-46; col. 9, lines 17-21; lines 35-38; and drawing Figs. 1, 5, 7, 8, 10, 11, and 12).

The fundamental standard of patentability under 35 U.S.C. § 103 is set forth in the decision by the United States Supreme Court in Graham et al v. John Deere Co., 148 USPQ 459 (1966). In that landmark decision the United States Supreme Court held that:

"Under Section 103, scope and content of prior art are to be determined, differences between prior art and claims are to be ascertained, and level of ordinary skill in the art resolved; against this background, obviousness of subject matter is to be determined. Such secondary considerations as commercial success, long felt but unsolved need, failure of others, etc. might be utilized too give light to the circumstances surrounding the origin of the subject matter to be patented. As indicia of obviousness or non-obviousness, these inquiries may have relevancy."

In the case of W. L. Gore and Associates, Inc. v. Garlock, Inc., 220 USPQ 303 (CAFC 1983). The Court of Appeals for the Federal Circuit held:

"There must have been something present in teachings in references to suggest to one skilled in art that claimed invention before court would have been obvious."

Likewise, as held by the Court of Appeals for the Federal Circuit in In re Newell, 13 USPQ2d 1248 (CAFC 1989):

"Determination that novel combination would have been obvious requires

supporting teaching in prior art, and retrospective view of inherency cannot serve as a substitute for actual teaching or suggestion in prior art which supports selection in use of various elements and particular claimed combination."

Furthermore, as held by the Court of Appeals for the Federal Circuit in Gillette Co. v. S.C. Johnson & Son Inc., 16 USPQ2d 1923 (CAFC 1990):

"Determination of obviousness under 35 USC 103 requires analysis of claimed invention as whole, and focusing on obviousness of substitutions and differences, instead of on invention as whole, is legally improper way to simplify that determination, nor should "obvious to try" be equated with obviousness."

In the present case there is certainly nothing in either reference that would suggest a modification of the Ong '816 reference to include the clamp (binder 13) of the Podosek reference. As previously noted, the incorporation of a sliding bar clamp of the type shown at 13 in the Podosek reference would perform no useful function in the Ong '816 reference since it would be totally redundant to the staples 16 in the Ong '816 reference.

Furthermore, such a combination would not meet any of the independent claims of the application, as amended, since the staples 16 in the Ong '816 reference would prevent rather than permit separation of the plurality of sheets of paper from the binder, as now

required by independent Claims 1 and 9. Likewise, the staples 16 of the Ong '816 reference would be contrary to the requirements of Independent Claim 6 for jaws "biased toward each other with sufficient force to clamp said plurality of pages together without the necessity of any binding margin fastener through said plurality of pages".

Also, the substitution of the report cover 14 folded as shown in Fig. 1 of the Ong '816 reference with the panel 34 thereof residing in face-to-face contact with and secured throughout its surface of contact to the top panel cover is directly contrary to the requirements of the Podosek reference for a lock portion of an elongated strip forming an acute angle at its intersection with the sheet from which the strip is secured and extending into the area between a rib and its respective side wall of a clamping strip. Such a teaching is found only in the present application.

It should be noted that the present application was not filed until more than five years had elapsed following the issuance of the Podosek reference. During that time apparently no one thought of the claimed combination of the present invention, despite the availability to the public of both the Ong '816 reference and the Podosek reference. As held by the United States Supreme Court in the Graham v. Deere decision, *supra*, the failure of others to invent the claimed invention during that time is relevant

As held in In Re Rothermel & Waddell, 125 USPQ 329 (CCPA 1960):

"Claims were rejected by what appears to be a piecemeal

reconstruction of prior art patents in light of applicants' disclosure; it is easy to attribute to prior art the knowledge which was first made available by applicants and then to assume that it would have been obvious to one having ordinary skill in the art to make these suggested reconstructions, but this is not the type of rejection which statute authorizes."

Likewise, as held by this Board in Ex parte Kristensen 10 USPQ2d 1701 (POBA&I 1989):

"Two prior patents in combination do not establish prima facie case of obviousness with respect to subject matter of appealed claims in patent application for liquid ejection nozzle, since latter patent does not teach or in any way suggest feature of application claims which is absent from earlier patent."

As held in Bela Seating Co v. Poloron Products, Inc., 160 USPQ 646 (1968):

"Patented combination cannot be anticipated in piecemeal fashion by combining individual features from different prior art patents when such combination is not taught by prior art patents themselves.

Device is patentable where it is a new combination resulting

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in an improved construction which accomplishes a new result and
which is markedly more efficient than prior devices."

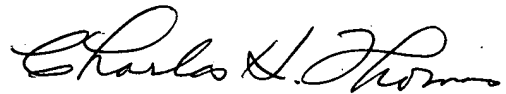
As held by the Patent Office Board of Patent Appeals and Interferences in Ex parte
Obukowicz, 27 USPQ2d 1063 (BPA&I 1993):

"Prior art reference that gives only general guidance and is not at all specific as
to particular form of claimed invention and how to achieve it may make certain
approach "obvious to try" but does not make invention obvious."

For all of the foregoing reasons, applicant believes that all of the claims of the
present application, as amended, are now in a condition for allowance. Applicant
respectfully requests reconsideration of the rejections, allowance of all claims and passage
of the application to issue in due course.

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Respectfully submitted,



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